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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/288,415	08/10/94	BRUGGER	4/19658A

001095
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HM42/1204

EXAMINER

BAWA, R

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 12/04/98 ²¹

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 08/288,415
Filing Date: 08/10/94
Appellant(s): Brugger et al.

MAILED
DEC 4 1998

Michael W. Glynn
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed on 9-4-98.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2-15.

Claim 1 has been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 9-4-98 has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,815,889	STETZ et al.	7-1955
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Gennaro (1985) Remington's Pharmaceutical Sciences. Mack Publishing Co., Easton, PA, pages 1670-1677.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gennoro, in view of Stetz et al. Gennaro discloses aerosol containers having protective coatings (p. 1670). Some examples of such coatings include oleoresin, phenolic, vinyl or epoxy coatings. It further discloses valves analogous to those claimed. Stetz et al. disclose aerosol delivery devices with metering devices analogous to those claimed.

It would be prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the "protective coatings" of Gennaro in the Stetz et al. delivery device and obtain the claimed aerosol container. The

motivation to incorporate this “protective coatings” is obtained from the fact that “epoxy coatings” (Gennaro) can be employed as “protective coatings” (Gennaro) in delivery devices analogous to those of Stetz et al. The Appellants’ argument that Gennaro offers no indication that these coatings can be employed to inhibit pharmaceuticals is not found persuasive.

Note that (I) a comprising-type language does not exclude other steps, elements or materials. *Cues Inc. Vs. Polymer Industries*, U.S.P.Q. 2d 1847 (DC ND GA 1988); (ii) it is well established that the claims are given the broadest interpretation during examination; (iii) a conclusion of obviousness under 35 U.S.C. 103 does not require absolute predictability, only a reasonable expectation of success; and (iv) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969). With respect to the Appellants’ arguments concerning claim 2 (pages 6-7), note that the compounds disclosed by Gennaro would make obvious “a plastic coating”. Once again note that references are evaluated by what they suggest to one of ordinary skill in the art rather than their specific disclosure.

In response to applicant's argument that Gennoro could not have been combined with Stetz et al., the test for obviousness is not whether the features of

a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

In response to the Appellants' argument concerning analogous art, note that it has been held that a prior art reference, in order to be relied upon as a basis for rejection of the claimed invention, must either be in the applicant's field of endeavor or, if not, then it must be reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992). In this case, the cited art is clearly analogous because it meets both of these criteria.

In light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103(a).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. Bawa".

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November 25, 1998

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